

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 50

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

FEB 23 2001

Ex parte HISATO SHINOHARA
and AKIRA SUGAWARA

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 1998-2015
Application No. 08/169,127

HEARD: January 16, 2001

Before JOHN DOUGLAS SMITH, KRATZ and DELMENDO, Administrative
Patent Judges.

KRATZ, Administrative Patent Judge.

ON REMAND TO THE EXAMINER

This appeal was taken pursuant to 35 U.S.C. § 134 from the final rejection of claims 1-16. Subsequent to the final action, several amendments were entered including an amendment canceling claims 5, 10 and 15. Consequently, this appeal involves the examiner's refusal to allow claims 1-4, 6-9, 11-14 and 16 as amended after final rejection.

From a review of the record of this application, this appeal is not ripe for decision at this time for several reasons as discussed below. Accordingly, this application is being remanded to the examiner for appropriate action.

BRIEF PROSECUTION HISTORY

1. The final action (Paper No. 13, pages 3-7) includes a rejection of claims 1-16 under 35 U.S.C. § 103 as unpatentable over Yamazaki et al. (U.S. Pat. No. 4,786,358) alone or in view of Yamazaki et al. (U.S. Pat. No. 4,680,855) and "Toshiba KK or NEC Corp (131) or (123) or Traskos et al. or Hongo et al or Krimmel et al." (answer, page 3).

2. The appellants' brief (Paper No. 24, pages 4 and 5) identifies the issues on appeal as:

A. Whether Appellants' claims 1-4, 6-9, 11-14 and 16 as amended by the first Amendment After Final are supported by Japanese priority application 61-229252.

B. Whether claims 1-4, 6-9, 11-14 and 16 are obvious in view of U.S. Patent No. 4,786,358 issued to Yamazaki et al. alone or in combination with U.S. Patent No. 4,680,855 or U.S. Patent No. 4,713,518 and Japanese Patent No. 403024259 to Toshiba KK or European Patent Application No. 209131 to NEC Corp. or U.S. Patent No. 4,915,981 issued to Traskos et al. or U.S. Patent No. 4,444,801 issued to Hongo or U.S. Patent No. 4,784,963 issued to Krimmel et al.

The issue and arguments sections of the brief do not address NEC Corp. 123 (Japanese Patent) as a reference being applied against the claims notwithstanding the application of that reference in the rejection set forth in the final rejection.

3. The examiner's answer (Paper No. 25, item No. 6) includes a statement agreeing with appellants' statement of the issues. However, the Grounds of Rejection section of the answer (item No. 11, page 5) includes a rejection of claims 1-4, 6-9, 11-14 under 35 U.S.C. § 103 as being unpatentable over Yamazaki et al. (U.S. Pat. No. 4,786,358) alone or in view of Yamazaki et al. (U.S. Pat. No. 4,680,855) and "Toshiba KK or NEC Corp (131) or (123) or Traskos et al. or Hongo et al or Krimmel et al." No rejection of claim 16 is made in the answer despite the examiner's agreement with appellants' statement of the issues in the brief which statement includes a § 103 rejection of claim 16 as an issue.

DISCUSSION

Our review of the present application file including the items identified above highlights the mixed signals broadcast by the examiner in agreeing with appellants' statement of the issues in the brief, a statement that does not address NEC Corp. 123 as an applied reference, and the rejection set forth in the answer

which includes NEC Corp. 123 as evidence being relied upon in rejecting claims 1-4, 6-9 and 11-14. This inconsistency is exacerbated by the examiner's apparent agreement with appellants' position that claim 16 stands rejected and the lack of a reference to claim 16 in the statement of rejection in the answer. We decline to speculate as to whether the examiner intends to continue to rely on NEC Corp. 123 as an applied reference and on whether a rejection of claim 16 was intended to be maintained in deciding this appeal.

Additionally, we observe that the examiner has not fully explained where the descriptive support for each claim on appeal, on a claim by claim basis, evaporates in the chain of parent applications and the priority document upon which appellants rely in traversing the examiner's § 103 rejection. This explanation is necessary since the prior art status of several of the references being relied upon by the examiner has been challenged by appellants in their briefs based on asserted 35 U.S.C. §§ 120 and 119 benefits. Hence, this matter clearly needs to be more fully developed prior to a decision being rendered on this appeal. In particular, we observe that appellants appear to have explained, in seemingly persuasive detail, where the claimed subject matter on appeal is supported in their priority document,

upon which they claim benefit (brief, pages 5 and 6). We note that the examiner's disagreement with appellants' assessment of the disclosure of the priority document hinges on an alleged lack of support in the priority document for the claimed condensing step in a second direction. However, the examiner's viewpoint does not appear to take into account the disclosure of the translated priority document furnished by appellants especially given the arguments set forth in the brief and the drawing figures 2(A)-(D) of that priority document. We particularly note that the examiner has not convincingly explained how the appealed claims require bending of a beam (answer, page 9) given that the plain language of the claimed condensing step of claims 1, 6 and 11 would appear to merely require that a condensing step of the laser beam occurs in a second direction orthogonal to a first direction so that a condensed beam having a line-shaped transverse cross-section at the object is formed. See appellants' specification at the paragraph bridging pages 6 and 7, for example.

Moreover, it is significant to note that the examiner has not fully developed where, if at all, a lack of support for the claimed subject matter, on a claim by claim basis, exists in the chain of prior U.S. patent applications that go back to the

priority document. The examiner should determine whether or not subject matter necessary to support the claims in the manner provided by 35 U.S.C. § 112, first paragraph has been carried forward from the priority document through each of the prior U.S. patent applications in the chain of applications in a manner consistent with 35 U.S.C. § 120 up to the present application so that the asserted § 119 benefits may be appropriately given effect. Appellants would surely help the examiner with that task, if such aid were sought by the examiner.

We further note that the examiner refers to several advisory actions at page 4 of the answer in discussing the priority document as it pertains to the rejection. Manifestly, setting forth a rejection in an Examiner's Answer by reference to more than one previous Office action is improper. As explained in Manual of Patent Examining Procedure (MPEP) § 1208 "Examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection (or a single other action on which it is based, MPEP § 706.07). Only those statements of grounds of rejection appearing in a single prior action may be incorporated by reference. An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action."

As another matter, we observe that the examiner, in response to a previous Remand, has indicated (Paper No. 44) that several of the translations of references of record were considered without the benefit of the examiner's simultaneous review of the foreign language document drawings since those references were apparently missing from the application file. Several of those allegedly missing references (JP 3-24259 and JP 2-174123) are at issue in this appeal. The examiner should review the application file to ensure that all papers are present therein including complete copies of all allegedly missing references and translations thereof. It is not apparent to us why the examiner has spent his/her resources determining the patentability of the subject matter on appeal, in part, from abstract(s) of the non-English language documents applied without translations and then from translations without the foreign language references including drawings being available for review rather than obtaining completely legible copies of the Japanese document(s) and complete translations thereof for concurrent review.

As a final matter, we note that the examiner (answer, page 9) has expressed a concern regarding a possible conflict between claim 15 of Yamazaki et al. (U.S. Pat. No. 4,786,358) and appellants' claims. Given that the identified real party in

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interest (brief, page 3) of this application is the assignee of U.S. Pat. No. 4,786,358, the examiner should determine whether an obviousness-type double patenting rejection may be appropriate.

Under the circumstances recounted above, the record before us is not in a condition which permits a proper disposition of the subject appeal. We are constrained, therefore, to remand this application for clarification of the file record with respect to the issues previously discussed. Moreover, it is our determination that a supplemental examiner's answer will not effect the record clarification necessary in this case.

Accordingly, the subject application is being returned to the jurisdiction of the examiner for reconsideration in light of the above and for addressing the above-noted deficiencies and clarifying the record in an appropriate office action in a manner that is consistent with current examining practice and procedure.

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APPROPRIATE ACTION

We remand this application to the examiner for action consistent with the above. This application, by virtue of its "special" status, requires an immediate action, MPEP § 708.01(d) 7th ed., Feb. 2000). It is important that the Board be promptly informed of any action (allowance, abandonment, reopening prosecution) affecting the appeal in this application.

REMANDED


JOHN D. SMITH)
Administrative Patent Judge)


PETER F. KRATZ)
Administrative Patent Judge)


ROMULO H. DELMENDO)
Administrative Patent Judge)

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

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